



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------------|------------------|
| 10/773,672 | 02/06/2004 | Shaul Ozeri | A&Z 20.959 (310216-00071) | 7531 |
| 7590 | 03/09/2006 | | EXAMINER SCHELL, LAURA C | |
| N. Paul Friederichs III Angenehm Law Firm, Ltd. PO Box 48755 Coon Rapids, MN 55448 | | | ART UNIT 3767 | PAPER NUMBER |

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | | |
|------------------------------|------------------------|--|---------------------|--|
| Office Action Summary | Application No. | | Applicant(s) | |
| | 10/773,672 | | OZERI ET AL. | |
| | Examiner | | Art Unit | |
| | Laura C. Schell | | 3767 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 9-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 9-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Species A in the reply filed on 8/15/2005 is acknowledged. The traversal is on the ground(s) that the previous examiner indicated that there is no generic claim, when in fact claim 1 is generic. The current examiner acknowledges that claim 1 is generic, however the requirement is still deemed proper because not all dependent claims are drawn to the same species and therefore it is made FINAL.

Claims 2, 4-8 and 16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 8/15/05.

Acknowledgements

Examiner acknowledges the amendment to the specification in which lines 5-7 on page 5 are deleted.

Communication with Attorney

A phone call was made on 3/6/06 to the attorney Paul Friederichs at phone number 763-493-4011. The attorney requested a phone call to clarify the questions regarding why claim 1 was not listed as a generic claim and to have the examiner delineate which claims read on the elected species A. Examiner left a voice mail message at the above telephone number describing that a previous examiner mistakenly decided that claim 1 was not generic when indeed it is generic. Also in the

voicemail message was a response that the examiner agrees with the attorney's assertion that claims 1, 3, 9-11 and 12-15 read on species A and were consequently examined in this office action. The attorney was invited to call the examiner at phone number 571-272-7881 if further questions arise.

Specification

The disclosure is objected to because of the following informalities: The first sentence in last paragraph of page 1 should omit "The" and begin with "In". The last sentence in the second paragraph of page 2 should change "possibility" to "possibly". The second to last sentence in the second paragraph on page 8 should change "them" to "then". The first sentence of the third paragraph on page 8 should change the endings of "manages, synchronizes and monitors" to endings in the past tense with endings in "...ed". The second sentence in the first paragraph of page 10 should change "The device's" to "the device". Lastly, it is unclear to the examiner what "led 203" is, in the last paragraph on page 8, and whether or not it is a spelling mistake. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following claim recitations: "logic means" in claims 1 and 10, and "power means" in claim 10 are not considered as invoking 35 USC 112 6th paragraph as they do not meet the 3 prong test set forth in MPEP 2181. Therefore, "logic means" will be considered as "logic device" and "power means" will be considered as "power mechanism" by the examiner.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 10, 13 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Flaherty et al. (US Patent No. 6,723,072). Flaherty discloses a micro pump device (Fig. 2) comprised of: a vertically expanding actuator (Figs. 2a-2c, 242) for applying pressure at the direction of the syringe plunger (260) wherein the actuator activation is controlled by programmable logic device (col. 4, line 60 through col. 5, line 6). Also see col. 9, lines 25-54. Flaherty further discloses a stopper element (205 and 225; also see col. 9, lines 35-41) that prevents the actuator from moving in the opposite direction; a plunger stem holder (Fig. 13 discloses a plunger stem (850) and holder (where 820 connects to 850)); guiding walls (Fig. 2, 232; also see col. 7, lines 19-30); and a power mechanism (Fig. 2, 80 and 50) causing gradual movement of the stopper (205) toward the actuator (242). Flaherty further discloses a microprocessor (Fig. 2, 50) that coordinates the power (80) and the actuator within predefined parameters and alerts the user of malfunctions (col. 5, line 7 through col. 6, line 21). Flaherty also discloses that the device includes communication means (Fig. 2, 60) for communicating with a remote

control unit (Fig. 1). Flaherty further discloses that the medical fluid is insulin (col. 4, lines 45-47).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Flaherty et al. (US Patent No. 6,723,072). Flaherty discloses the device substantially as claimed including that the actuator can be a piezoelectric element (col. 15, lines 47-49), however the exact specifications of use of a piezoelectric element are not described by Flaherty. It is obvious to one of ordinary skill in the art at the time of the invention, however, to have substituted the piezoelectric element for the shape memory wires used by Flaherty in order to produce an actuator that uses a piezoelectric element which expands in the direction of the plunger stem upon receiving electrical current.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Flaherty in view of Faeser et al. (US Patent No. 4,544,336). Flaherty discloses the device substantially as claimed including guiding walls, however, Flaherty does not disclose that the guiding walls are supported by springs. Faeser, discloses an infusion pump with a spring-loaded wall (col. 4, line 66 through col. 5, line 35). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Flaherty with the spring-loaded wall of Faeser, in order to provide an infusion

Art Unit: 3767

pump with a path with pressure-applying guide walls in order to help a piston traveling in that path to remain in sealing engagement with the walls.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Flaherty in view of Niehoff (US Patent No. 5,928,197). Flaherty discloses the device substantially as claimed except for an optical encoder or a force sensor. Niehoff, however, discloses an infusion pump with an optical encoder and a pressure sense circuit that senses the pressure within the syringe, the data from both of which is then analyzed and compared against accepted values (col. 9, lines 25-38). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Flaherty with the encoder and sensor circuit as taught by Niehoff, in order to provide a way of monitoring the activity of the infusion pump and then using the feedback to control it.

Claims 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flaherty in view of Das et al. (US Patent No. 6,423,035). Flaherty discloses the device substantially as claimed except for the device housing being watertight. Das, however, discloses that the housing of the infusion pump is watertight (see last sentence of the abstract). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Flaherty with the watertight housing as taught by Das in order to provide an infusion pump that could be used when showering or bathing.

Art Unit: 3767

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura C. Schell whose telephone number is (571) 272-7881. The examiner can normally be reached on Monday-Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571) 272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LCS

LCS



**MICHAEL J. HAYES
PRIMARY EXAMINER**